OIPE IAP28
OCT 14 2005
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Utility Patent Application of

Whead Gordon Peoples

Application No: 10/672,287

Filing Date: September 26, 2003

For: SHOE INSERT PAD

Mailing Date of Final Office Action: April 8, 2005

TRANSMITTAL

Commissioner for Patents
Mail Stop RCE
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action, Mailing Date April 8, 2005, enclosed are the following:

1. Request for Continued Examination;
2. Request for 3 month Extension;
3. Authorization to Charge Deposit Account in the amount of $860.00;
4. Final Office Action; and
5. Preliminary Amendment.

Respectfully submitted,

SCOTT J. FIELDS
Registration No. 32,857

Date: 10/11/05

NATIONAL IP RIGHTS CENTER, LLC
550 Township Line Road, Suite 400
Blue Bell, PA 19422
(610) 680-2301

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CERTIFICATE OF MAILING

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Alexandria, VA 22313-1450

I, Scott J. Fields certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to the Commissioner for Patents, Mail Stop Missing Parts, P.O. Box 1450, Alexandria, VA 22313-1450.

SCOTT J. FIELDS

Date: 10/11/05

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,287	09/26/2003	Whead Gordon Peoples	10388 - 1	8319

7590 04/08/2005

National IP Rights Center, LLC
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EXAMINER	
PATTERSON, MARIE D	

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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OCT 14 2005
PATENT & TRADEMARK OFFICE

Office Action Summary

Application No.	Applicant(s)	
10/672,287	PEOPLES, WHEAD GORDON	
Examiner	**Art Unit**	
Marie Patterson	3728	

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner in view of Fisher (5611153).

Gardner shows an insert pad made of foam with planar surfaces substantially as claimed except for the exact foam material. Fisher teaches the use of polyethylene vinyl acetate foam with a density of between 2 and 35 pounds per cubic foot for an insert pad. It would have been obvious to use the material taught by Fisher in the pad of Gardner to provide adequate shock absorbing properties.

In reference to claim 13, Gardner as modified above discloses the claimed invention except for the exact thickness of the insert pad. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the pad 3/16 inch thick, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In reference to the phrase "a uniform edge", the edge of Gardner is considered uniform, i.e constant, always the same. The edge does not change, the edge is awlays the edge.

3. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Moore III (5733647) or McElroy (4627179) in view of Fisher (5611153).

Either Moore III or McElroy shows an insert pad made of foam with planar surfaces substantially as claimed except for the exact foam material. Fisher teaches the use of polyethylene vinyl acetate foam with a density of between 2 and 35 pounds per cubic foot for an insert pad. It would have been obvious to use the material taught by Fisher in the pad of either Moore III or McElroy to provide adequate shock absorbing properties.

In reference to claim 13, either Moore III or McElroy as modified above discloses the claimed invention except for the exact thickness of the insert pad. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the pad 3/16 inch thick, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

4. Applicant's arguments filed 3/30/05 have been fully considered but they are not persuasive. .

In response to Applicant's argument that the prior art does not include certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., an insert which is of a uniform thickness throughout) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are

anticipated or unpatentable. Constant v. Advanced Micro-Devices Inc., 7 USPQ2d 1064. The claim language does not recite that the thickness of the insert is constant or uniform. The claim recites that there is a "uniform edge" and that the edge has a thickness of 3/16 inch. There is no requirement for the uniformity of the edge to be in the thickness.

5. Applicant's arguments with respect to claims 10-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see **http://pair-direct.uspto.gov**. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at *(703) 872-9306* **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.

Marie Patterson
Primary Examiner
Art Unit 3728